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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/042,612      | 01/09/2002  | Matthew I. Egbe      | 5669                | 7021             |

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03/24/2004

EXAMINER

KORNAKOV, MICHAIL

ART UNIT. PAPER NUMBER

1746

DATE MAILED: 03/24/2004

12

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/042,612

Applicant(s)

EGBE ET AL.

Examiner

Michael Kornakov

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5, 13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 13 and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on February 17, 2004 has been entered.
2. Applicants amended claim 1 to introduce the limitation of water soluble organic solvent range of 30-90 wt.% versus 80-90 wt%, as appeared in the previously allowed claims. Applicants submitted that previous amendment setting forth the range of 80-90 wt.% was "an obvious typographical error". However, the reasons for allowance clearly indicates that it is the amendment to the range that distinguished the present claims from the prior art, and that the range as appeared in the amended claims was the major reason for allowance. New claims 13 and 14 are added. Claims 6 and 7 are cancelled. Claims 8-12 stand withdrawn from consideration, as being drawn to non-elected invention.
3. Claims 1-5 and 13, 14 are examined on the merits.
4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office actions.

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5. Claims 1-5, 13 and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by or in the alternative as obvious over Inoue et al (U.S. 6,232,283).

Inoue teaches a liquid detergent composition comprising 30% of monoethanolamine (col.3, lines 35, 60-65 and col.10, line 62), strait chain alkylbenzene sulfonic acid with C8-C22 carbons (reads on dodecylbenzene sulfonic acid) in the amount of 1-30% (col.12, line 60, col.2, line 42, col.10, lines 60-65), and at least 40% of water (col.10, lines 63-65, and Tables 1 and 2). This reads on the limitations of claims 1, 3 and 4. With regard to claims 2, 5 and 13, 14 Inoue teaches the presence of malonic acid (col.3, line 45), which can be introduced in the amount of 0.01-30% (col. 1, line 61). Malonic acid of Inoue acts as a corrosion inhibitor, since it is the compound used by Applicants as corrosion inhibitor. Therefore, the composition as claimed can be envisaged by one of an ordinary skill in the art.

In the event that one of the ordinary skill in the art would not immediately envisage Applicants' instantly claimed composition, then the composition is rendered obvious from the disclosure found in the prior art reference to Inoue. The prior art contains each of Applicants' instantly claimed ingredients and clearly suggests to one of ordinary skill in the art that they be used in combination as claimed. Such a suggestion renders obvious Applicants' instantly claimed composition, and as such, the claims are not patentable.

6. Claims 1-5, 13 and 14 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Jones (U.S. 4,199,483).

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Jones discloses a detergent cleaning composition (abstract), comprising from 20-75%, preferably 30-60% of water soluble detergent surfactant (col.2, lines 5-10), which is preferably monoethanolamine (col.6, lines 35-40). This is component (A) of the instant claim 1 and further a component identified in the instant claim 2. Another component of Jones is a salt of an alkylbenzene sulfonic acid, wherein the alkyl group contains C9-C15 (col.5, lines 60-65). This reads on dodecylbenzene sulfonic acid. The composition of Jones contains 1-75% of water (col.7, lines 40-45).

The mixture of alkanolamine and alkali metal salt of alkylbenzene sulfonic acid is a preferred surfactant system in Jones (col.6, lines 32-37). This mixture is utilized in the amount of 20-75% of the composition. Such teaching allows to those skilled in the art clearly envisage the claimed components in the ranges as instantly claimed. With regard to claims 13 and 14 Jones utilizes corrosion inhibitor in the amounts of 1-3% by weight (col.6, lines 50-55). With specific regard to claim 5, Jones utilizes benzotriazole in his corrosion inhibiting composition (col.9, line 30). Therefore, the composition of the instant claims is anticipated by Jones.

In the event that one of the ordinary skill in the art would not immediately envisage Applicants' instantly claimed composition, then the composition is rendered obvious from the disclosure found in the prior art reference to Jones. The Jones Patent contains each of Applicants' instantly claimed ingredients and clearly suggests to one of ordinary skill in the art that they be used in combination as claimed. Such a suggestion renders obvious Applicants' instantly claimed composition, and as such, the claims are not patentable.

***Response to Arguments***

7. Applicant's arguments filed 02/17/2003 have been fully considered but they are not persuasive.

***Relative to Jones reference ('483 Patent):*** Applicants arguments reside in contention that the examples of Jones show 30.2 wt.% of an alkylbenzene sulfonic acid, and the amount of alcohol and alkanolamine of 9.5%. Applicants further state that such ranges are outside Applicants claimed ranges. In response to this Applicants attention is drawn to a generic teaching of Jones who provides for 20-75% of combined detergent surfactant (col.2, lines 5 and 6), wherein the preferable composition of such detergent surfactant is a mixture of mono-di or triethanolamine with alkali metal salt of benzene sulfonic acid (col.6, lines 30-40). Applicants are advised that disclosed examples and preferred embodiments do not constitute a teaching away from a **broader disclosure or non-preferred embodiments**, consult ***In re Susi***, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, **including non-preferred embodiments**, consult *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989). See also *Celeritas Technologies Ltd. v. Rockwell International Corp.*, 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir.1998).

***Relative to Inoue ('283 patent):*** The crux of Applicant's arguments is that Inoue does not disclose all of the required elements of Applicants claimed invention that fall within

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the same weight percentage ranges. This is not found persuasive, since Inoue teaches a liquid detergent composition comprising 30% of monoethanolamine (col.3, lines 35 and 60-65 and col.10, line 62), strait chain alkylbenzne sulfonic acid with C8-C22 carbons (reads on dodecylbenzene sulfonic acid) in the amount of 0.01-30% (col.1, lines 55-60, col.2, line 36, and 42, col.12, line 60, col.10, lines 60-65), and at least 40% of water (col.10, lines 63-65, and Tables 1 and 2), which is identical to the instantly claimed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Kornakov whose telephone number is (571) 272-1303. The examiner can normally be reached on 9:00am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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*M. Kornakov*

*3/19/04*

Michael Kornakov  
Examiner  
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